

## REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of the present Amendment, Claims 1-2, 10-19, and 23, 25, and 27 will be all the claims currently pending for the Examiner's consideration. Of the pending claims, Claims 1, 2, and 10-19 are withdrawn from consideration and Claims 24 and 26 are hereby canceled. Claims 23, 25, and 27 are amended. No new matter is added.

The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

### **I. Claim Rejections:**

Claims 23-27 stand rejected under section 112, first paragraph, as failing to comply with the written description requirement related to the recitation of synergistic ratios between the compound of formula (I) and a further compound as defined in the claims. In addition the Claims 23-24 remain rejected under 103 as being obvious over Erdelen et al., US Pub No. 2003/0149080 in view of Leightley et al., USPN 5,223,178. Applicants respectfully disagree as follows.

Regarding support for Applicants' claim of unexpected results. While an applicant should describe in the application the property or properties alleged to exhibit unexpected results, evidence of undisclosed advantages that would inherently flow from what was disclosed in the specification can be used to establish unexpected and superior results. *In re Davies*, 475 F.2d at 670, 177 U.S.P.Q. at 385; see also, *In re*

*Zenitz*, 333 F.2d 924, 142 U.S.P.Q. 158 (C.C.P.A. 1964), and *In re Khelghatian*, 364 F.2d 870, 150 U.S.P.Q. 661 (C.C.P.A. 1966).

Accordingly, an applicant need not describe in the specification properties that "would inherently flow" from what is disclosed to claim unexpected superiority based on those properties.

The above is also consistent with the long standing rule that the function of the written description requirement is "[t]o ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; to comply with the description requirement, it is not necessary that the application describe the claimed invention in *ipsis verbis*; all that is required is that it reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him." *In re Edwards*, 568 F.2d at 1351-52, 196 U.S.P.Q. at 467 (citations omitted).

The present application discloses that mixtures with thiacloprid and various selected fungicides such as quaternary ammonium compounds and boron compounds would be preferred (page 2, [0066] and page 3, [0070] and [0084] and ([0094] for benzalkonium chloride) in the published US patent application).

Moreover, the specification also discloses that "[t]he active compound of the formula (I) can be employed in combination with at least one other active compound from the group of the insecticides or the fungicides, to widen the activity spectrum or to achieve particular effects, such as, for example, additional protection against wood-destroying fungi." (page 2, [0066]).

Therefore, the instantly claimed mixtures should be accepted as being supported in the Applicants' disclosure. As such, Applicants respectfully submit the claimed invention complies with the written description requirement and the rejections should now be withdrawn.

In addition, the invention as claimed demonstrates unexpected and superior results indicating the non-obviousness of the invention. Often with chemical inventions, applicants combine two obvious compounds and assert non-obviousness based on synergism. In *Ex parte Quadranti*, the Board noted synergy may be used to establish non-obviousness and that there are "many appropriate methods of demonstrating synergism." *Id.*, 25 U.S.P.Q.2d at 1073. As such, Applicants respectfully submit the claimed invention is non-obvious and these rejections should now also be withdrawn.

**II. Conclusion:**

In summary, it is respectfully submitted that independent Claims 23, 25, and 27 fully distinguish over the applied art and are thus in condition for allowance. (The remaining dependent claims being rejoivable and allowable as well.)

Notice to the effect is earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

The USPTO is hereby authorized to charge any fees which may be required by this paper and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully submitted,

By



Nicanor A. Kohncke  
Attorney for Applicants  
Reg. No. 57,348

LANXESS CORPORATION  
Law & Intellectual Property Department  
111 RIDC Park West Drive  
Pittsburgh, Pennsylvania 15275-1112  
(412) 809-2234  
FACSIMILE PHONE NUMBER:  
(412) 809-1054

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